

## REMARKS

After entering the instant amendment, claims 1-3 and 5-30 are pending in the present application, claim 4 having been previously cancelled and its subject matter incorporated into amended claim 2. Claim 30 was previously added. Claim 1 has been amended to make clear that composition is a personal cleansing composition (the claims are now directed to personal care cleansing products). Note also that the claims have been amended such that the two distinct liquid layers which occur after the composition settles after mixing is an element of the composition, not simply a phrase in the preamble of claim 1. Applicants believe that with the presentation of the instant amendment and the removal of the Examiner's concern regarding the preamble limitation of the previously submitted claim 1, the instant application is now in condition for allowance. Support for the amendments to the claims can be found throughout the original specification and claims and in particular in the preamble of claim 1 and in the first full paragraph on page 13.

The Examiner has rejected the previously pending claims variously under 35 U.S.C. §102 and 103 for the reasons which are presented in the office action dated April 21, 2004. Applicants respectfully traverse the Examiner's rejections for the reasons which are presented in the sections which follow.

### The §102 Rejections

The Examiner has rejected claims 1, 8, 11, 13, 16 and 22 under 35 U.S.C. §as being anticipated by U.S. patent no. 4,293,305 ("Wilson"). Essentially, the Examiner argues that Wilson, which discloses a composition in example 7 which contains propylene glycol benzoate as a high density aromatic ester and a polyoxyethylene compound or alkyl ether phosphate, which read on the claimed surfactants, the present claims are anticipated. Applicants respectfully traverse the Examiner's rejection here.

The present invention relates to personal cleansing compositions such as body cleansers and shampoos, for example, which are multiple phase surfactant compositions comprising at

least two distinct and separate liquid phases upon settling, wherein the compositions comprise a first or lower high density layer comprising at least one high density aromatic ester (as defined in the specification on page 7 as a high density aromatic ester emollient/conditioning agent) having a specific gravity of greater than 1.00 and at least one additional layer comprising a surfactant solution having a specific gravity which is less than the specific gravity of the high density layer. The present invention is directed to compositions which exhibit activity as surfactant compositions having emollient characteristics and a pleasant two-layered liquid presentation. The compositions are particularly adapted as personal care cleansing compositions having both cosmetic characteristics and favorable presentation. Thus, the present invention relates to personal care compositions which exhibit excellent surfactant and emollient/conditioning characteristics with a superior presentation, that presentation being the separation of the product into at least two distinct liquid layers upon settling after mixing.

Wilson does not anticipate the present invention. In the first instance, Wilson is directed to textile processing compositions which contain components such as cycloaliphatic diester textile treating components which are not included in compositions according to the present invention. Note the amended claims which are directed to personal cleansing products (personal care products) comprising the claimed components cannot include components such as those disclosed in Wilson, which would negate its use as a personal cleansing product. Just based upon this single distinction, the present claims are not anticipated by the disclosure of Wilson. In addition, there is absolutely no evidence that any of the examples of Wilson would produce a multi-layered composition upon settling. There is absolutely no reason to produce more than one layer in the Wilson disclosed compositions and in particular, if the Wilson compositions were multi-layered, such multi-layering could have significant deleterious consequences (reduced efficacy) for the intended purpose disclosed in Wilson- that of treating textiles. Moreover, in Wilson, which is directed to *industrial textile treating compositions*, there is absolutely no reason to provide a multi-layered effect which would give rise to a cosmetically pleasing presentation as is the case with the present invention. Indeed, the concept of an industrial textile cleaner is completely foreign to the favorable cosmetic presentation of the present invention. There is absolutely no reason to believe Wilson created anything remotely related to the present invention. Wilson clearly does not anticipate the present invention.

The Examiner has separately rejected claims 1-3, 5-6, 8-21 and 24-27 as being anticipated by U.S. patent no. 6,043,204 to Kaufman, et al. ("Kaufman"). The Examiner cites Kaufman for teaching the use of octyl methoxy cinnamate (column 5, lines 44-45), relevant surfactants (column 6, lines 5-45), exfoliating agents (column 8, line 35 for lactic and glycolic acid), penetration enhancers (column 8, lines 32-33 for propylene glycol, butylene glycol and glycerin) and the claimed low-density oil (column 7, lines 45-67). From this disclosure the Examiner argues that Kaufman anticipates the present invention.

The present invention, as described above, is referenced here. There is absolutely no evidence in Kaufman that Kaufman provides a disclosure which produces the presently claimed invention. In order to make this rejection and content that the present invention is anticipated, the Examiner has had to cherry-pick numerous disclosed components and simply argue that *somewhere, somehow* one of ordinary skill would formulate a composition using the Kaufman disclosed components to produce the claimed invention. That is simply not cogent, because Kaufman does not disclose the desirability of multi-layers and does not teach to make such a personal cleansing composition. Kaufman does not even teach to use a high density composition and a low density composition in the same composition to get a layered effect in personal cleansing compositions.

The Examiner seems to think it is possible to accidentally/inadvertently produce the claimed invention by inadvertently combining a high density component with a low density component to produce the multi-layered composition. To the extent that the Examiner argues that Kaufman produces the claimed compositions by accident, that disclosure is simply not sufficient to anticipate the claimed invention. To anticipate the claims of the present invention, the Examiner must point to a specific example of a composition which, when it is formulated, provides all of the elements of the claimed composition. In order to find a claimed invention invalid under the doctrine of inherency, the Examiner must show that one of ordinary skill following the teachings of the reference *necessarily, inevitably and always* produces every element of the claimed invention. Mere possibilities, probabilities or accidents are not sufficient for making out a proper case under the doctrine of inherency. The result must be *absolutely certain*. See, the previously cited cases In re Robertson, 169 F.3d 743, 49 U.S.P.Q.2d 1949 (Fed.

Cir. 1999); Glaxo, Inc. V. Novopharm, Ltd., 52 F.3d 1043, 34 U.S.P.Q.2d 1565 (Fed. Cir. 1995), *cert. denied*, 116 S.Ct. 516 (1995); Electro Medical Systems, S.A. v. Cooper Life System, Inc., 34 F.3d 1048, 32 U.S.P.Q.2d (Fed. Cir. 1994); Continental Can Co. USA v. Monsanto Co., 948 F.2d 1264, 1269, 20 U.S.P.Q.2d 1746, 1749 (Fed. Cir. 1991); W.L. Gore & Assocs., Inc. v. Garlock, Inc., 721 F.2d 1540, 1553-54, 220 U.S.P.Q. 303, 313-14 (Fed. Cir. 1983), *cert. denied*, 469 U.S. 851 (1984); In re Oelrich, 666 F.2d 578, 581, 212 U.S.P.Q. 323, 325-26 (C.C.P.A 1981); and Phillips Petroleum Co. v. U.S. Steel Corp, 673 F.Supp. 1278, 1295 n.12, 6 U.S.P.Q.2d 1065, 1076-77 n.12 (D.Del. 1987), among others. It is respectfully submitted that the Examiner cannot cite or point to a single composition of Kaufman which can even arguably be said to anticipate the present invention. As stated, to the extent the Examiner is relying on the disclosure of Kaufman to provide an inadvertent teaching of the present invention, that disclosure is deficient and does not anticipate the present invention. Kaufman does not anticipate the present invention.

#### The §103 Rejection

The Examiner has also rejected previously filed claims 1-21 and 24-27 as being unpatentable over a combination of US 2002/20160023 of Bagdi, et al. ("Bagdi") and Kaufman. The Examiner cites Badli (same as PGPUB '023) as teaching multiphase formulations (see examples 1 and 2 for three and four phase formulations). The Examiner cites Bagdi further for teaching penetration enhancers, oils and exfoliating agents. The Examiner contends that Bagdi suggests the incorporation of sunscreens (the high density esters of the present invention). The Examiner cites Kaufman for teaching surfactants for use in body cleansing compositions along with other claimed ingredients.

Accordingly, the Examiner argues that it would have been obvious to one of ordinary skill in the art at the time of the present invention to prepare multiphase compositions of Bagdi and add the claimed sunscreens and surfactants of Kaufman for their beneficial effect on the skin. The motivation stems from the scientific knowledge that surfactants are used mostly in cleansing compositions and the motivation to add the sunscreen to the composition to provide

protection from the sun. This, the Examiner contends, makes out a *prima facie* case of obviousness. Applicants respectfully traverse the Examiner's rejection.

The present invention relates to personal care cleansing products which are multiphasic and which produce at least two distinct liquid layers upon settling after mixing. The disclosures of Bagdi and Kaufman in combination in no way render the present invention obvious. Moreover, it is respectfully submitted that the Examiner has not made out a cogent case that the present invention is *prima facie* obvious over a combination of Bagdi and Kauman.

The present invention relates to personal cleansing compositions such as body cleansers and shampoos, for example, which are multiple phase surfactant compositions comprising at least two distinct and separate liquid phases upon settling after mixing, wherein the compositions comprise a first or lower high density layer comprising at least one high density aromatic ester (as defined in the specification on page 7 as a high density aromatic ester emollient/conditioning agent) having a specific gravity of greater than 1.00 and at least one additional layer comprising a surfactant solution having a specific gravity which is less than the specific gravity of the high density layer. The present invention is directed to compositions which exhibit activity as surfactant compositions having emollient characteristics and a pleasant two-layered liquid presentation. The compositions are particularly adapted as personal care cleansing compositions having both cosmetic characteristics and favorable presentation. Thus, the present invention relates to personal care compositions which exhibit excellent surfactant and emollient/conditioning characteristics with a superior presentation, that presentation being the separation of the product into at least two distinct liquid layers.

Bagdi does not disclose or suggest the present invention. Bagdi, as perhaps hundreds of patents and other references in the cosmetic field, discloses the preparation of formulations by first preparing a composition in separate phases (actually, simple mixtures) and then mixes the phases together to form a final formulation or composition. Bagdi does not disclose or suggest that the phases should separate into at least two distinct liquid layers upon settling after mixing the final formulation. Indeed, such a proposition, is actually counterintuitive from the disclosure of Bagdi. Without any suggestion to provide a composition which actually separates into two

distinct layers upon settling after mixing, Bagdi does nothing to render the present invention obvious.

Kaufman, for reasons which have been previously stated, is not directed to compositions according to the present invention. For the reasons previously discussed, Kaufman does not make out an anticipatory rejection and cannot possibly *inherently* anticipate the present invention. Moreover, there is absolutely no disclosure in Kaufman which would motivate one of ordinary skill to produce the present compositions- indeed the concept that gives rise to the present invention- that of allowing two distinct layers to form upon settling after mixing- is actually anathema to the teachings of Kaufman.

Without a rationale which recognizes that the separation of a composition into distinct layers is actually cosmetically *favorable* (as opposed to a negative characteristic generally recognized by those in the art as representative of instability), there can be no motivation in a combination of Kaufman and Bagdi to produce the present invention. Most formulation chemists actually work to *avoid* phase separation. This is unlike the present invention which actively encourages phase separation because it is desirable cosmetically. Because there is no motivation to create the present invention, there is nothing in the combined disclosure of Kaufman and Bagdi which would result in the production of the present invention which is directed to compositions which form distinct liquid layers upon settling after mixing. Note that in the examples in Bagdi and Kaufman, the final products which are produced are *uniform*, and in the particular case of Bagdi, the homogenous compositions are gelled- precisely to lock in and avoid any separation into layers which are critical to the present invention. Thus, the combined teachings of Kaufman and Bagdi actually *teach away* from the present invention at the point of invention (the multiphase layered nature of the final composition) and cannot be cogently used to render the present invention obvious. Without some motivation or teaching (which is absent from Kaufman and Bagdi), the person of ordinary skill would provide a uniform, homogenous composition and would actually *avoid* the present invention.

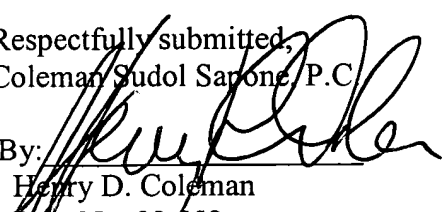
For all of the above reasons, it is respectfully submitted that the present application is now in condition for allowance and such action is earnestly solicited. No claim has been added

or cancelled. No fee is therefore due for the presentation of this amendment. If the Examiner decides that any fee is required, the Commissioner is authorized to charge any such fee or credit any such overpayment to deposit account 04-0838.

An indication of any charge made to the authorized Deposit Account is respectfully requested at the time of the issuance of a further office action, so that the charge may be accurately tracked for accounting purposes.

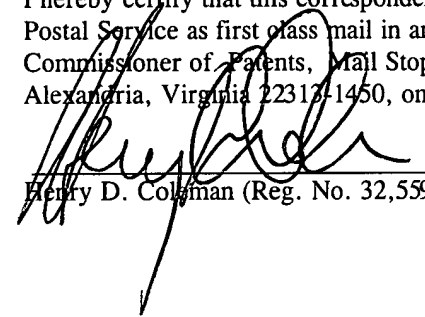
Dated: \_\_\_\_\_

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